

REMARKS

The foregoing amendment and the following arguments are provided generally to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

The Office Action mailed October 6, 2005 asserted that:

“The reply filed on 7-8-05 is not fully responsive to the prior Office Action because: claim objections to claims 69, 70, 93 and 94, and 35 U.S.C. 112 rejections to claims 37, 57, 77, 97 were not addressed.” (Page 2, the first paragraph under the heading “response to amendment”, Office Action mailed October 6, 2005).

Applicant respectfully disagrees.

In the prior Office Action mailed April 4, 2005, claims 69-70 were objected to for the lack of antecedent basis for the limitation “the predetermined range”; and claims 93-94 were objected to for the lack of antecedent basis for the limitation “the criteria”. Applicant respectfully submits that the amendment mailed July 5, 2005 provides sufficient antecedent basis for these limitation.

For example, claims 69-70 are dependent claims of independent claim 57, which recites: “... a rate within a predetermined range of the selected service provider ...”, which provides sufficient antecedent basis for the limitation “the predetermined range” recited in claims 69-70.

For example, claims 93-94 are dependent claims of independent claim 77, which recites: “... a pre-established set of criteria ...”, which provides sufficient basis for the limitation “the criteria” recited in claims 93-94.

In the prior Office Action mailed April 4, 2005, claims 37, 57, 77 and 97 were rejected under 35 U.S.C. 112, first paragraph. The remarks/arguments on page 15 of the response mailed July 5, 2005 address these rejections.

Thus, the prior response mailed July 5, 2005 is fully responsive to the prior Office Action mailed April 4, 2005. Withdrawal of the assertion of “not fully responsive” is respectfully requested.

MPEP (714.03) provides:

“Where an amendment substantially responds to the rejections, objections, or requirements in a non-final Office action (and is a bona fide attempt to advance the application to final action) but contains a minor deficiency (e.g., fails to treat every rejection, objection or requirement), the examiner may simply act on the amendment and issue a new (non-final or final) Office action. The new Office action may simply reiterate the rejection, objection, or requirement not addressed by the amendment (or otherwise indicate that such rejection, objection, or requirement is no longer applicable).” (MPEP 714.03)

Since the Office Action mailed October 6, 2005 appears to be a new Office Action, it is respectfully assumed that the amendment mailed July 5, 2005 was accepted, entered, and acted upon.

Claim Objections

Claim 66 was objected to for reciting “the form”. Currently pending claim 66 does not recite “the form”. Thus, the withdrawal of the objection for claim 66 is respectfully requested.

Claim 68 was objected to. Claim 68 has been canceled. Thus, the withdrawal of the objection for claim 68 is respectfully requested.

Claims 69-70 were objected to for the lack of antecedent basis for the limitation “the predetermined range”. Applicant respectfully submits that the base claim 57 of claims 69-70 provides sufficient antecedent basis for the limitation “the predetermined range” in claims 69-70, as discussed above. Thus, the withdrawal of the objection for claims 69-70 is respectfully requested.

Claim 76 was objected to. Claim 76 has been canceled. Thus, the withdrawal of the objection for claim 76 is respectfully requested.

Claim 83 was objected to for reciting “the service provider ends”. Applicant respectfully submits that claim 83 no longer recites “the service provider ends”. Thus, the withdrawal of the objection for claim 83 is respectfully requested.

Claims 85-86 were objected to for reciting “the information”. Applicant respectfully submits that claims 85-86 no longer recite “the information”. Thus, the withdrawal of the objection for claims 85-86 is respectfully requested.

Claim 88 was objected to. Claim 88 has been canceled. Thus, the withdrawal of the objection for claim 88 is respectfully requested.

Claims 93-94 were objected to for reciting “the criteria”. Applicant respectfully submits that the base claim 77 of claims 93-94 provides sufficient antecedent basis for the limitation “the criteria” in claims 93-94, as discussed above. Thus, the withdrawal of the objection for claims 93-94 is respectfully requested.

Rejections Under 35 U.S.C. §112

Claim 96 was rejected under 35 U.S.C. §112, second paragraph. Claim 96 has been canceled. Thus, the withdrawal of the rejection for claim 96 is respectfully requested.

Claim 37 was rejected under 35 U.S.C. §112, first paragraph, for the lack of support in the specification for the limitation “an alternate service provider pre-selected by the service provider”. Applicant respectfully disagrees. At the very least, the original application discloses the selected service provider pre-selecting the alternate service provider by way of original claim 38 filed in the original application.

Further, claim 37 recites “an alternate service provider elected in advance by the selected service provider”, which is described in the original application in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or

use the invention. For example, the original claims 38 and 78 recite “the selected service provider designates an alternate service provider in advance”. For example, the third paragraph on page 12 of the description shows:

“In one embodiment, the service provider would be able to set up ahead of time a referral, as described above, in case a call should come while they were unavailable. For example, she can elect to have the call patched through to a backup service provider of her choice, have one selected from the database for her, or have the user just be told that the service provider was not available and to try back later. In one embodiment, if the service provider chooses to refer the call to someone else or to the database, that service provider will receive a percentage of whatever fees were earned. This may be an incentive for the service provider to refer.” (Page 12, lines 18-25, original description of the present application).

Thus, the withdrawal of the rejection for claim 37 under 35 U.S.C. §112, first paragraph, is respectfully requested.

Claims 57, 77 and 97 were rejected under 35 U.S.C. §112, first paragraph, for the lack of support in the specification for the limitation “the list to indicate a real-time availability and a rate of each alternate provider”. Applicant respectfully submits that currently pending claims 57, 77 and 97 do not recite the limitation “the list to indicate a real-time availability and a rate of each *alternate* provider”.

Further, for example, Figure 3 of the present application shows “a rate or price per minute 340” and “hyperlink 350 that shows whether or not the service provider is available”. See, also, for example, pages 10-11 of the description of the present application.

Thus, the withdrawal of the rejection for claims 57, 77 and 97 under 35 U.S.C. §112, first paragraph, is respectfully requested.

Rejections Under 35 U.S.C. §103(a)

The Office Action rejected the claims under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,389,278 (hereinafter “Singh”), in view of U.S. Patent Application Publication No. 2002/0010608 (hereinafter “Faber”) and further in view of U.S. Patent No. 5,915,214 (hereinafter “Reece”) and other references, such as U.S. Patent Application Publication No. 2002/0095359 (hereinafter “Mangetsu”), U.S. Patent Application Publication No. 2002/0193135 (hereinafter “Nakano”), etc. Applicant respectfully disagrees.

Applicant respectfully submits that some of the references relied up for the rejections are not proper prior art references.

35 U.S.C. §103(c) provides:

“(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Faber was assigned on January 7, 2000 to keen.com, the same assignee of the present application. Faber was published on January 24, 2002, after the filing date of the present application (January 16, 2001). Thus, the rejection under 35 U.S.C. §103(a) based on Faber is improper.

Further, MPEP (2136.03.I) provides:

“35 U.S.C. 102(e) is explicitly limited to certain references “filed in the United States before the invention thereof by the applicant” (emphasis added). Foreign applications’ filing dates that are claimed (via 35 U.S.C. 119(a) – (d), (f) or 365(a)) in applications, which have been published as U.S. or WIPO application publications or patented in the U.S., may not be used as 35 U.S.C.

102(e) dates for prior art purposes. This includes international filing dates claimed as foreign priority dates under 35 U.S.C. 365(a). Therefore, the foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date. ... ” (2136.03.I, MPEP)

Mangetsu was filed in the United States on December 19, 2001, which is after the filing date of the present application (January 16, 2001). Thus, Mangetsu is not a proper prior art reference under 35 U.S.C. 102(e).

Nakano was filed as a PCT application on October 26, 2001, which is after the filing date of the present application (January 16, 2001). Furthermore, the PCT publication of Nakano (WO 02/37715) is not in English. Thus, Nakano is not a proper prior art reference under 35 U.S.C. 102(e).

The Office Action admits that “Singh failed to teach “a rate of each service provider”” and relied upon Faber for the limitation. Since Faber is not a proper prior art reference, the rejection under 35 U.S.C. §103(a) is improper.

Further, claim 101 recites “wherein the system is remote to the user”. In Singh, the processing logic is in the wireless communicator (see, e.g., Figure 1A and 1B of Singh), which appears to be a handheld device that the user uses to place the radiotelephone call. The wireless communicator performs the operations described in Singh.

However, in one embodiment of the present invention, a system (e.g., 130) provides the service over network (e.g., 150) and telephone interface (e.g., 170). See, for example, Figure 1 of the present application. It is understood that such a system of the present application is very different from the wireless communicator of Singh.

For example, Singh does not show the wireless communicator *providing* the list *via the Internet*. However, claim 1 recites “a first logic unit to provide a list of service providers via a communication connection”.

For example, Singh does not show the wireless communicator receiving the user selection over a telephone connection. However, claim 7 recites “the selection is received over a telephone connection”.

For example, Singh does not show the wireless communicator receiving the user selection over the Internet. However, claim 8 recites “the selection is received over the communication connection which includes an Internet connection”.

Further, MPEP (2143.03) provides

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Manual of Patent Examining Procedure (MPEP) 2143.03).

Applicant's independent claims 17, 37, 57, 77 and 97 include claim limitations that are not disclosed nor suggested by the References. Therefore, applicant's independent claims are patentable over the References.

In particular, applicant's independent claims include the claim limitation, or limitation similar thereto, of:

“offering the user an option to connect to an alternate service provider elected in advance by the selected service provider, including searching a database of alternate service providers, in response to a failed attempt to connect the selected service provider and the user, for an alternate service provider based on a pre-established set of criteria comprising one or more of: a rate within a predetermined range of a rate of the selected service provider, subject matter, and a reliability factor indicating a ratio of successful attempts to connect the alternate service provider and previous users to total attempts to connect the alternate service provider and previous users.” (see, e.g., Applicant's independent claim 77)

Therefore, since applicant's independent claims 17, 37, 57, 77 and 97 have claim limitations that are not disclosed in, nor suggested by, the cited references, applicant's independent claims are patentable over the cited references.

Applicant's remaining claims depend from one of the foregoing independent claims and therefore incorporate the distinguishing limitations of the foregoing independent claims. Therefore, the remaining dependent claims are also patentable over the cited references.

Claims 5, 25, 45, 59 and 85 were rejected under 35 U.S.C. §103(a) as being unpatentable over Singh in view of Faber and Reece, as applied to claim 4, and further in view of U.S. Patent No. 6,563,915 (hereinafter "Salimando"). Since Salimando was relied upon only for the additional limitations recited in claims 5, 25, 45, 59 and 85, claims 5, 25, 45, 59 and 85 are patentable over the cited references at least for the reasons discussed above for the base claims of claims 5, 25, 45, 59 and 85.

Claims 8, 20-23, 41, 81 were rejected under 35 U.S.C. §103(a) as being unpatentable over Singh in view of Faber and Reece, as applied to claim 1, and further in view of U.S. Patent Application Publication No. 2002/0095359 (hereinafter "Mangetsu"). Since Mangetsu was relied upon only for the additional limitations recited in claims 8, 20-23, 41, 81, claims 8, 20-23, 41, 81 are patentable over the cited references at least for the reasons discussed above for the base claims of claims 8, 20-23, 41, 81.

Claim 62 was rejected under 35 U.S.C. §103(a) as being unpatentable over Singh in view of Faber and Reece, as applied to claim 57, and further in view of alleged knowledge in the field. Since the alleged knowledge in the field was relied upon only for the additional limitations recited in claim 62, claim 62 is patentable over the cited references at least for the reasons discussed above for the base claim of claim 62.

Claims 65 and 66 were rejected under 35 U.S.C. §103(a) as being unpatentable over Singh in view of Faber and Reece, as applied to claim 1, and further in view of U.S. Patent No. 6,067,561 (hereinafter "Dillon"). Since Dillon was relied upon only for the additional limitations

recited in claims 65 and 66, claims 65 and 66 are patentable over the cited references at least for the reasons discussed above for the base claim of claims 65 and 66.

Claim 99 was rejected under 35 U.S.C. §103(a) as being unpatentable over Singh in view of Faber and Reece, as applied to claim 97, and further in view of U.S. Patent No. 6,542,732 (hereinafter “Khazaka”). Since Khazaka was relied upon only for the additional limitations recited in claim 99, claim 99 is patentable over the cited references at least for the reasons discussed above for the base claim of claim 99.

Claim 100 was rejected under 35 U.S.C. §103(a) as being unpatentable over Singh in view of Faber and Reece, as applied to claim 97, and further in view of U.S. Patent No. 6,611,501 (hereinafter “Owen”). Since Owen was relied upon only for the additional limitations recited in claim 100, claim 100 is patentable over the cited references at least for the reasons discussed above for the base claim of claim 100.

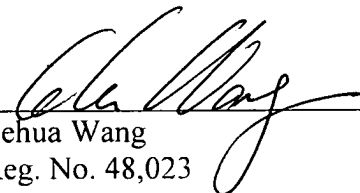
Thus, the withdrawal of the rejections under 35 U.S.C. §103(a) is respectfully requested.

CONCLUSION

It is respectfully submitted that all of the Examiner's objections have been successfully traversed and that the application is now in order for allowance. Accordingly, reconsideration of the application and allowance thereof is courteously solicited.

Respectfully submitted,

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